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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/697,306	10/27/2000	James F. McGuckin JR.	10546/53003	4213

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NEW YORK, NY 10038

EXAMINER

DAWSON, GLENN K

ART UNIT PAPER NUMBER

3731

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER
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MAILED
SEP - 7 2004
GROUP 3700

Glenn K Dawson
Primary Examiner
Art Unit: 3731



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/697,306
Filing Date: October 27, 2000
Appellant(s): MCGUCKIN, JAMES F.

Oleg F. Kaplun

For Appellant

EXAMINER'S ANSWER

MAILED
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GROUP 3700

This is in response to the appeal brief filed 04-30-04.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because the arguments do not outline why claims 44-48 are believed to be separately patentable. As is required in 37 CFR 1.192.

(8) *Claims Appealed*

Claims 49-51 have been indicated as being allowable and therefore are not appealed claims.

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(9) Prior Art of Record

5,395,030	Kuramoto, et al.	03-1995
5,389,098	Tsuruta, et al.	02-1995
5,562,694	Sauer, et al.	10-1996
DE 4006673	Kessel	09-1991

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 36-38,40-44 and 46-48 are rejected under 35 U.S.C. 102(e). This rejection is set forth in a prior Office Action, mailed on 11-07-03.

Claims 36-48 are rejected under 35 U.S.C. 103. This rejection is set forth in a prior Office Action, mailed on 11-07-03.

(11) Response to Argument

The appellant argues that the examiner gave fig. 27 in support of the tissue graspers being capable of grasping tissue and drawing it into the cutting zone. Actually the examiner relied upon fig. 25 which shows the curving forceps and the embodiments which go along with the use of the forceps are found in fig. 22-27. The appellants arguments with respect to fig. 27 show that the appellant has properly construed that the capsule in the embodiment with the forceps would include 138. The appellant has not argued that Kuramoto does not disclose a capsule with a coupling structure for selectively coupling to a flexible endoscope. The examiner contends that the capsule is coupled to the distal end of the endoscope. The argument against Kuramoto is for

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allegedly not disclosing a tissue grabber which is capable of grasping a fold of tissue and bringing it into the cutting zone and this argument is not persuasive in that as shown in figures 22-27, the forceps 150 could easily grasp a fold of tissue present between the anvil 148 and the stapler 124 and pull it into the cutting zone adjacent the cutter 138a. Fig. 25 shows that the forceps when extended is not perfectly aligned with aperture 154 and in any event, once the anvil engaged tissue as shown in fig. 24, the forceps could easily grasp tissue present anywhere between 138 and 146. Even if it were precisely aligned with the shaft 147, it still could grasp tissue between the tip of the shaft 147 and the member 138 from where the forceps extend. The examiner considers the limitation of the grasper grasping a fold of tissue and drawing it into the cutting zone to be purely functional in nature and that the prior art forceps 150 is capable of performing that claimed function. As shown in fig. 23 and 24, the forceps needs to be guided, presumably with the endoscope 122, 123, into position to allow the forceps to align with the shaft 147 of the anvil. This clearly would allow for the forceps to be misaligned with the shaft 147, or into any other orientation such that it could grasp tissue between the distal end of 138 and the anvil shaft 147. Additionally, the argument that no cutting zone is formed when the anvil is unconnected to the housing 138 is unpersuasive as the cutting zone is always the zone adjacent to the cutter whether the anvil is connected to the housing or not. It is not incumbent for the forceps of Kuramoto to perform the claimed function to offer assistance in the performance of the function of the device of Kuramoto, as maintained on page 6 and 7 of the appeal brief. The claimed function or use could be diametrically opposed to the disclosed function of Kuramoto.

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The only issue at hand is whether the forceps of Kuramoto "could" be used to grasp tissue and draw it into the cutting zone adjacent to the cutter. The issue as to whether anyone would find utility in doing so, or would have found it obvious is irrelevant.

Contrary to applicant's insistence that Tsuruta discloses a rigid stapler and cutter, the examiner again directs attention to col. 34 lines 6-14 where it states that the insertion section can be rigid or "flexible" and that the components extending through it such as the wires for operating the stapler should be made out of flexible materials to allow them to bend as well. Therefore, clearly a flexible member in use would extend through the body and to the control handle 1. With regards to the statement on page 9 of the brief that the examiner is using hindsight, this argument is not persuasive. The statement used by the examiner and cited by the appellant was one in which the appellant argued that even if the device were disclosed as being flexible, there was insufficient disclosure in the patent to show how one would be able to make the device flexible. The examiner contends that one skilled in the art would easily be capable of making the appropriate working elements of the device flexible to make the operating section "flexible" as taught in col. 34 noted above. There is no hindsight as no modification of the device with respect to it being flexible is necessary. The device of Tsuruta is flexible as claimed. Additionally, the argument as to the inappropriateness of providing the stapler of Tsuruta with forceps based on the disclosure in col. 22 lines 20-22 of Tsuruta that the tissues can be gathered without using forceps is again unpersuasive for at least two reasons. Firstly, the embodiment of the stapler shown in fig. 46-50 is the only one in which the manner in which it is used would not require or

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find forceps helpful in its operation. The device shown in fig. 1-3 of Tsuruta has a two-piece operating capsule 3 and 4, one piece of which has the cutter and stapler, and the other of which has an anvil. The manner in which this device is used is entirely different in that tissue must be directed between the two parts of the capsule in order for the device to operate properly. Therefore, the statement with regards to no forceps being necessary to gather the tissue together is not relevant here because there is no two sides of tissue which need to be gathered together, the devices operate entirely differently, and tissue does need to be directed to the cutting zone between the parts 3 and 4 of the capsule.

The examiner also would like to address the applicant's statement that the inventor thought it advantageous not to include graspers and that "the examiner has conceded that this is true" is not accurate. Additionally, many other people of ordinary skill in the art, including patent examiners, when provided with an invention of a patent, would easily be able to contemplate various facilitating modifications to the prior art device not contemplated by the patentee. The argument that a patentee would know more about what would or would not facilitate the use of his invention in the time following the publication of the patent is not persuasive and is refutable every day, in that most patent applications are drawn towards improvements to previous inventions, not entirely new inventions. Just because one patentee saw no use of a particular modification to his/her invention does not mean that in the presence of good and sufficient evidence for the addition of the particular modification that said evidence should be ignored.

The examiner has stated that while the forceps are not required that use of such would enhance the operation of the device. The motivation for such an argument comes from the reference to Sauer which clearly discloses the use of internal forceps to grasp tissue and draw it into a cutting zone. As this clearly would prove beneficial in the embodiments of Tsuruta which have opening and closing capsules, the teachings of Sauer of providing an internal tissue grasper to draw tissue into a cutting zone, the examiner contends that such is analogous art and one which is properly combinable with Kuramoto.

The argument against Kessel is one in which Kessel has no relevance to surgical stapling and shows a body lumen being accessed via an incision. The device of Kessel is an endoscopic biopsy forceps. A flexible endoscope is routed through the forceps to allow for visualizing the operative field to allow the surgeon to see which tissue should be biopsied. The examiner is unable to find that any of figures 1-3 show accessing a body via an incision. Fig.1 shows the cross-section of the forceps whereby the endoscope is routed through channel 18 in the wall of the endoscope. No body lumen or a figure showing the device in use is shown. In any event, the examiner contends that a flexible endoscope internal to a forceps for engaging tissue would prove to be analogous and useful to procedures in intra-cavity operations. Tsuruta discloses in col. 33 line 67-col. 34 line 5 that "the distal end of the cartridge can be seen well through an endoscope, enabling a surgeon to see whether or no that portion of the organ to which he or she wants to apply staples is located inside the distal end portion of the cartridge." Clearly a means by which to assist in the visualization of the operative field


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would have proved beneficial in the stapler of Tsuruta. Once it is found obvious to have incorporated the endoscope in the device of Tsuruta as modified by Sauer to include inner grasping forceps, the inner lumen in the wall of the device which would receive the endoscope would be the claimed coupling structure. It should then be apparent that the examiner has outlined both an anticipation of claims 36-38, 40-44 and 46-48 by Kuramoto and a prima facie case of obviousness of claims 36-48 by the combination of Tsuruta, Sauer and Kessel, and the examiner respectfully requests that the above rejections be affirmed.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,


Glenn K Dawson
Primary Examiner
Art Unit 3731

gkd
September 4, 2004

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